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**FEB 28 2005**

**OFFICE OF PETITIONS**

|                               |   |                      |
|-------------------------------|---|----------------------|
| In re Application of          | : |                      |
| Witzel                        | : |                      |
| Application No. 10/054,893    | : | DECISION ON PETITION |
| Filing Date: 25 January, 2002 | : |                      |
| Attorney Docket No. 39452     | : |                      |

This is a decision on the petition filed on 5 January, 2004, and resubmitted on 14 January, 16 April and 3 August, 2004, and then again via FAX on 25 February, 2005, alleging, *inter alia*, improper abandonment by the Office and requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is  
**DISMISSED**,

**NOTES:**

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.181, or 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b) (as to unintentional delay) **must be submitted within two (2) months from the mail date of this decision.** Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a

cover letter entitled "Petition under 37 C.F.R. §1.137(a)"; or "Petition under 37 C.F.R. §1.137(b)";

- (2) Thereafter, there will be no further reconsideration of this matter.

### BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 13 March, 2003, with reply due absent extension of time on or before 13 June, 2003;
- the application went abandoned after midnight 13 June, 2003;
- the Office mailed a Notice of Abandonment on 20 October, 2003;
- it appears from the record that Petitioner filed a reply on or about 12 November, 2003, however, Petitioner did not seek to have withdrawn the holding of abandonment until the filing of a petition on 5 January, 2004, which was resubmitted on 14 January, 16 April and 3 August, 2004, and then again via FAX on 25 February, 2005;
- with his petition(s), Petitioner has included, *inter alia*:
  - a copy of a reply alleged to have been filed via FAX on 10 June, 2003;
  - copies of Petitioner's FAX transmittal certificate dated 10 June, 2003 (however, the certificate references "an amendment dated May 13, 2003," and the amendment document submitted with it is dated "June 5, 2003") and confirmation of transmission from Petitioner's FAX machine;
  - a copy of an Auto-Reply Facsimile Transmission confirming Office receipt of Petitioner's submission on 14 January, 2004;
- notably there is no Auto-Reply Facsimile Transmission confirming Office receipt of Petitioner's submission on 10 June, 2003.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

And petitions calling upon the authority of the Commissioner to act, such as that under 37 C.F.R. §1.181,<sup>7</sup> require diligence as to their filing—i.e., the petition must be filed within two months of the action complained of.

Allegations as to the Request to Withdraw  
the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>8</sup>

While the instant petition was not timely filed, the more difficult problem with which Petitioner is confronted in the instant petition is that, while Petitioner seeks to make a showing that he submitted a reply, there is no showing that the Office received that reply. The regulations at 37 C.F.R. §1.8 can either support a showing of:

- timely submission of a reply that is later received by the Office as a result of the transmission, or
- due diligence with regard to unavoidable delay as to a submission that is not later received by the Office as a result of the transmission.

The former condition may support the showing required as to a request to withdraw the holding

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<sup>7</sup> The regulations at 37 C.F.R. §1.181 provide:

**§ 1.181 Petition to the Commissioner.**

- (a) Petition may be taken to the Commissioner:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
  - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
  - (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.
- (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.
- (c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
- (d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.
- (e) Oral hearing will not be granted except when considered necessary by the Commissioner.
- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
- (g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.
- [24 Fed. Reg. 10332, Dec. 22, 1959; 34 Fed. Reg. 18857, Nov. 26, 1969; paras. (d) and (g), 47 Fed. Reg. 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 Fed. Reg. 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

<sup>8</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

of abandonment under 37 C.F.R. §1.181, while the latter may support the showing required as to a petition to revive alleging unavoidable delay under 37 C.F.R. §1.137(a).

Thus, as of this writing Petitioner fails to satisfy the required showing as to withdrawal of the holding of abandonment—and it does not appear that he will be able to do so.

### CONCLUSION

Because Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

### ALTERNATIVE VENUE

It appears unlikely that Petitioner likely is able to make a showing to support a request to withdraw the holding of abandonment. Therefore, Petitioner's only alternative to irretrievable abandonment is to:

- file a petition under 37 C.F.R. §1.137(a) or §1.137(b) with fee: and
- ensure that Petitioner also has satisfied the “reply” and “showing” requirements under the respective regulations as to unavoidable or unintentional delay.

Thus, Petitioner may wish to supplement the petition to plead alternatively under 37 C.F.R. §1.137(a) or §1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings  
(703) 872-9306  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to be 'J. Gillon', with a stylized flourish at the end.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions